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REMARKS

Claims 1-34 remain in the application for further prosecution. Claim 13 has been amended.

Claims 9-12, 23, and 32 have been allowed. Claims 5, 8, 14, 19, 22, 28, and 31 have been objected to as being dependent upon a rejected base claim. Claims 1, 4, 13, 15, 18, 24, 27, 33, and 34 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 5,600,411 (“Hart”) in combination with U.S. Patent Number 6,125,841 (“Boudreault”). Claims 2, 16, and 25 have been rejected under § 103(a) as being unpatentable over Hart in combination with Boudreault and further in combination with U.S. Patent Number 5,190,666 (“Bisconte”). Claims 3, 6, 7, 17, 20, 21, 26, 29, and 30 have been rejected under § 103(a) as being unpatentable over Hart in combination with Boudreault and further in combination with U.S. Patent Number 6,494,940 (“Hak”).

Allowable subject matter

Claims 9-12, 23, and 32 have been allowed, and claims 5, 8, 14, 19, 22, 28, and 31 are allowable except for being dependent upon a rejected base claim.

Claims rejected under 35 U.S.C. § 103(a)

Claims 1, 4, 13, 15, 18, 24, 27, 33, and 34 have been rejected under § 103(a) as being unpatentable over Hart in view of Boudreault. In addition to the rejection over Hart in view of Boudreault, claims 2, 16, and 25 have been rejected in further view of Bisconte, and claims 3, 6, 7, 17, 20, 21, 26, 29, and 30 have been rejected in further view of Hak. Claims 1, 13, 15, 24, 33, and 34 are the only remaining rejected independent claims (“rejected independent claims”).

In general, regarding the rejected independent claims, the Office Action alleges that Hart discloses a “generally rectilinear filter housing,” that Boudreault discloses “at least two filter assemblies,” and that it “would have been obvious to person having ordinary skill in the art at the time of the invention was made to modify the device of Hart

to include at least two filter assemblies as taught by Boudreault for the purpose of increasing the filter area.”

Hart and Boudreault are NOT Analogous Prior Art

To rely on a reference under § 103, the reference must be analogous prior art. Manual of Patent Examining Procedure (“MPEP”), Eighth Edition, Incorporating Revision No. 1, Section 2141.01(a), page 2100-117. Thus, “to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). For example, the Federal Circuit has held that a hook and eye fastener for use in garments was not within the field of the applicant’s endeavor, which was related to a “hook” improvement in a hose clamp. *Id.*

In our case, Hart is directed to a filtration device for use in a printing system. For example, the specification states that the “present invention relates to a developer apparatus for electrophotographic printing” and, specifically, to a “filter for filtering toner.” Column 1, lines 3-5. In fact, the entire background section provides numerous examples of prior art, including nine patents, each example describing a device used in a printing machine. Some of the examples described in the background section are: a toner reclaim filtration device (column 3, lines 40-44), a recycling device for use in an electrographic copier or printer (column 3, lines 47-50), and a device for filling and filtering toner for use in a photocopier (column 3, lines 61-64). Similarly, in the description section Hart discloses that “there is shown an illustrative electrophotographic printing machine incorporating the development apparatus of the present invention,” Column 5, lines 50-52. In fact, Hart emphasizes that the disclosed filter is used mainly with a toner system, *i.e.*, a printing machine:

It should be appreciated that the use of apparatus or filter 90 is adaptable to development systems utilizing primarily toner or toner and carrier (developer).

Column 7, lines 18-21.

Each one of claims 1, 13, 15, 33, and 34 is related to a circuit breaker. For example, claim 1 is directed to an “improved filter assembly for a circuit breaker,” claims 13 and 34 are directed to a “circuit breaker assembly,” claim 15 is directed to a “method of filtering high energy arcing in a circuit breaker,” and claim 33 is directed to a “method for assembling a circuit breaker assembly.” Thus, regarding claims 1, 13, 15, 33, and 34, Hart is not in the field of the Applicants’ endeavor. Nor is Hart reasonably pertinent to the problem with which the Applicants were concerned. While the Applicants were concerned, for example, with ensuring that interruption gasses pass through the filters (not around the filters) and with providing structural integrity for the filter assembly (*see* “Background of the Invention,” page 2 and 3), Hart was concerned with filtering toner for a printing machine.

Similarly, Boudreault is not analogous art because it is directed to a device for removing grease from a kitchen hood. As Boudreault describes in the “Field of the Invention” section, the broad scope of the invention is directed to the “removal and biodegradation of grease material from a kitchen ventilator.” Column 1, lines 13-15. Further, Boudreault provides that the “invention relates specifically to an exhaust hood for separating and biodegrading grease particles. Column 1, lines 16-17. The detailed scope of the invention explains that “the invention relates to a device which makes it possible to separate grease particles in air loaded with grease, produced by a cooking unit and to further biodegrade any grease that has not been drained away and that may remain on filters or deflectors used to separate it from air.” Column 1, lines 18-22. Clearly, one of ordinary skill in the art would not look to the removal of grease from a kitchen hood for answers in solving circuit breaker problems more than one would look to garments for solving problems related to a hose clamp.

Thus, Applicants respectfully submit that claims 1, 13, 15, 33, and 34 are not obvious over Hart in view of Boudreault at least for the reasons described above. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP, Section 2143.03, page 2100-128 (citing *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Accordingly, Applicants respectfully submit that claims

2-4, 6, 7, 16-18, 20, and 21 are nonobvious for at least the same reasons as explained above.

The Prior Art Does NOT Suggest or Motivate to Modify the References

Obviousness can only be established “by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP, Section 2143.01, page 2100-125. No matter how simple the technological concept, a motivation must be found. For example, in *In re Kotzab* the claims were directed to an injection molding method having a single temperature sensor for controlling a plurality of flow control valves. 217 F.3d 136, 1371 (Fed. Cir. 2000). The primary cited reference taught that a multizone device included multiple sensors, each sensor controlling a corresponding flow control valve, and that one system may be used to control a number of valves. *Id.* The Federal Circuit Court of Appeals found that the evidence was insufficient to show that one system was the same as one sensor. *Id.* Although the control of multiple sensors was a “technologically simple concept,” there was no motivation “within the knowledge of the skilled artisan” to use a single sensor as the system to control more than one valve. *Id.*

The rejected independent claims are limited to a “generally rectilinear filter housing” including “at least two filter assemblies.” Although the Examiner has admitted that Hart “fails to disclose at least two filter assemblies configured for interfitting,” the Examiner has alleged that Boudreault discloses “at least two filter assemblies.” Office Action, page 2. At best, however, Boudreault discloses a plurality of filter assemblies that are mounted side by side as individual units. The only references to the use of a plurality of filter assemblies state that “more than one filter assembly 11 may be provided, such as six in the case illustrated in FIG. 3” (column 4, lines 53-55), and that an exhaust hood may include “baffle filters mounted side by side” (claim 11). Referring to FIGs. 2 and 3, it is clear that Boudreault teaches the use of a filter assembly unit, as shown in FIG. 2, being mounted together with a number of other similar units, as shown in FIG. 3.

In other words, the filter assemblies are not a single unit but a plurality of units mounted side by side.

Our case is similar to the facts in the *In re Kotzab* decision, which has been described above. The claims in the present invention are directed to a single housing having a plurality of filter assemblies. Similarly, the claims in *In re Kotzab* were directed to a single sensor controlling a plurality of valves. Hart teaches a single housing having a single filter assembly. Similarly, the primary cited reference of *In re Kotzab* taught that a single sensor controls a single valve. Boudreault teaches using a plurality of individual filter assemblies mounted side by side.

Much more persuasive than in our case, the primary cited reference of *In re Kotzab* actually taught that one system can control a plurality of valves. In our case, Boudreault does not even come close to teaching that the filter assemblies can be integrated into one generally rectilinear filter housing. Thus, it should be apparent from the above fact comparison between our case and *In re Kotzab* that the Federal Circuit would most likely decide that no motivation can be found in the combination of Hart and Boudreault to teach a “generally rectilinear filter housing” that includes “at least two filter assemblies.”

Thus, Applicants respectfully submit that claims 1, 13, 15, 24, 33, and 34 are not obvious over Hart in view of Boudreault at least for the reasons described above. Applicants also respectfully submit that claims 2-4, 6, 7, 16-18, 20, 21, 25-27, 29, and 30 are nonobvious for at least the same reasons as explained above.

The Prior Art Does NOT Teach or Suggest All Claim Limitations

To establish a *prima facie* case of obviousness all claim limitations must be taught or suggested by the cited references. *See generally, In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970). Thus, the Examiner must adhere to the basic principle that the Applicants’ claimed invention must be considered as a whole, including the problem Applicants’ invention solves. MPEP, § 2141, page 2100-116, and § 2141.02, page 2100-120.

As mentioned above, all the rejected independent claims are limited to a “generally rectilinear filter housing” including “at least two filter assemblies.” Even if there would be a motivation or suggestion to combine Hart and Boudreault, the result would simply be a plurality of filter assemblies mounted side by side, not a “generally rectilinear filter housing” having “at least two filter assemblies.”

Specifically, claims 1 and 13 are limited to a “generally rectilinear filter housing having at least two filter mounting zones for receiving at least two filter assemblies, so as to define, in the aggregate, a filter assembly.” Claims 15 and 24 are limited to “mounting at least two filter assemblies with a generally rectilinear filter housing having at least two filter mounting zones so as to define, in the aggregate, a filter assembly.” Claim 33 is limited to “providing a generally rectilinear filter housing and at least two filter assemblies, said filter housing having at least two filter mounting zones . . . each of said filter mounting zones receiving one of said filter assemblies.” Claim 34 is limited to “a generally rectilinear filter housing having at least two filter mounting zones; and at least two filter assemblies, each of said filter assemblies being configured for interfitting a respective one of said filter mounting zones.” Thus, all the rejected independent claims are limited to having two filter mounting zones for receiving two filter assemblies in a filter housing.

The Examiner has admitted that Hart “fails to disclose at least two filter assemblies configured for interfitting.” If Hart fails to disclose at least two filter assemblies, then, it necessarily follows that Hart fails to disclose a “generally rectilinear filter housing” having “at least two filter mounting zones.” Similarly, Boudreault fails to teach a “generally rectilinear filter housing” having “at least two filter mounting zones.” The closest support found in Boudreault is the statement that “more than one filter assembly 11 may be provided, such as six in the case illustrated in FIG. 3.” Column 4, lines 53-55. But this statement does not teach that a filter housing can include two filter mounting zones. In fact, referring to FIG. 3, it seems obvious that the filter assemblies 11 were merely mounted side by side in the exhaust hood. For example, an analogous scenario in the present invention would be to mount a plurality of filter housings side by side in a circuit breaker.

Thus, Applicants respectfully submit that claims 1, 13, 15, 24, 33, and 34 are not obvious over Hart in view of Boudreault at least for the reasons described above.

Applicants also respectfully submit that claims 2-4, 6, 7, 16-18, 20, 21, 25-27, 29, and 30 are nonobvious for at least the same reasons as explained above.

Claims 1, 13, and 34 are further limited to a “filter gasket configured for interfitting about a periphery” of the filter body. Claim 33 is further limited to “interfitting a filter gasket about a periphery” of the filter body. Each filter includes a gasket. Because claims 1, 13, 33, and 34 are limited to having at least two filters, it necessarily follows that at least two gaskets are used, one for each filter.

In Fig. 1 Hart discloses a gasket 150 which is mounted between the upper housing 108 and a mounting plate 122. The gasket 150 is not interfitted about the periphery of any of the shown filters, filter 134, filter 140, and filter 144. The specification specifically refers to only one gasket 150 which is “[l]ocated on top of the upper screen mounting plate 122.” Column 8, lines 60-61: Thus, while the gasket of claims 1, 13, 33, and 34 is interfitted about the filter body periphery, the gasket disclosed by Hart is mounted on one side of a mounting plate, which is connected to the filter 134. Further, while claims 1, 13, 33, and 34 are limited to at least two gaskets, one for each filter, Hart only discloses one gasket.

Although Hart describes a gasket, Boudreault describes none. There is no mention of a gasket anywhere in the specification or in the drawings. Clearly, this claim limitation is not taught by the combination of Hart and Boudreault.

Thus, Applicants respectfully submit that claims 1, 13, 33, and 34 are not obvious over Hart in view of Boudreault at least for the reasons described above. Applicants also respectfully submit that claims 2-4, 6, and 7 are nonobvious for at least the same reasons as explained above.

Conclusion

It is the Applicants' belief that all the pending claims are now in condition for allowance, and thus reconsideration of this application is respectfully requested. If there

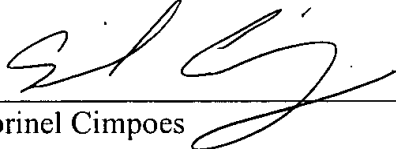
are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is believed that no fee is presently due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47181-00248.

Respectfully submitted,

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By


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